

REMARKS

A Petition for Extension of Time is being concurrently filed with this Reply. Thus, this Reply is being timely filed.

Status of the Claims

In the present Reply, claim 1, 9 and 15-18 have been amended. Also, claim 20 has been canceled. Further, claims 3-5 stand withdrawn from consideration. This makes claims 1-19 as pending in the present application.

No new matter has been added with the amendment to claim 1, as the subject matter from canceled claim 20 has been incorporated into claim 1. The changes to claims 9 and 15-18 are obviously minor in character and not narrowing in scope. By deleting/amending these terms in order to clarify the claimed invention (e.g., "benzotriazol" to "benzotriazole"), Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 102(b)

Claims 1, 2 and 6-20 stand rejected as being anticipated by Oikawa '081 (U.S. Patent No. 6,114,081) (see paragraphs 1-2 of the Office Action). Applicants respectfully traverse.

In the claimed invention, the silver amount in the silver halide photographic light-sensitive material is 3.0 g/m^2 or less. In this regard, the specification of the present application states: "However, if a light-sensitive material of a low silver content is quickly processed, there are caused a problem of residual color and a problem that fluctuations of photographic properties (dot % fluctuation, decrease of density etc.) become significant" (see page 2, lines 26-30 of the present specification). Based on this finding, the instantly claimed invention was made.

The cited Oikawa '081 reference fails to disclose this finding, and also does not describe the relation between the silver amount and the problems of the residual color and fluctuations of photographic properties. In this regard, Applicants respectfully refer the Examiner to the examples in Oikawa '081 (start at column 98, line 40), wherein its examples merely show a value of 3.3 g/m^2 versus what is instantly claimed (see, e.g., column 100, line 45, etc.). In other words, Oikawa '081 fails to disclose reducing the silver amount as presently claimed, and therefore the claimed invention is patentably distinct from the disclosure in the cited reference.

Thus, this rejection has been overcome. Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Oikawa '081 reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, reconsideration and withdrawal of this rejection are respectfully requested.

Issues of Double Patenting

Claims 1, 2 and 6-20 stand provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over the claims of co-pending Application No. 10/768,440 (hereinafter "the '440 Application") (see paragraphs 3-4 of the outstanding Office Action). Applicants respectfully traverse.

Applicants note that the '440 Application has a U.S. filing date of February 2, 2004, which is later than the U.S. filing of this application (September 29, 2003). Thus, Applicants respectfully submit that any provisional obviousness-type double patenting rejection would be more appropriate in the '440 Application, since the '440 Application would have a patent term that expires at a later date versus this application. Otherwise, Applicants respectfully request that the Examiner hold this rejection in abeyance until this or the '440 application issues as a patent.

Rejoinder Requested

Once the instant provisional rejection is withdrawn, Applicants respectfully request rejoinder of the species recited in withdrawn claims 3-5.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

Application No. 10/671,939

Art Unit 1752


Reply to Office Action of July 11, 2006

Docket No.: 2870-0267P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatchouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant